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GROUP 240

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Patent Application of)
RAYMOND C. MCGARVEY) Art Unit: 2406
Serial No. 07/937,560) Examiner: S. Cummings
Filed: August 31, 1992)
For: Minimum Dead Volume Fitting)

PETITION FROM REQUIREMENT FOR RESTRICTION
UNDER 37 C.F.R. 1.144

Honorable Commissioner of Patents
and Trademarks
Washington, D.C. 20231

Sir:

This is a petition from the restriction requirement made in the Office Action mailed on July 6, 1993 and made final in the final Office Action mailed on March 18, 1994.

In the Election and Amendment filed on July 20, 1993, the applicant pointed out errors in the restriction requirement and requested an action on the merits of all of the claims. More particularly, the applicant pointed out the reasons why several, if not most, of the claims of the present application are generic to all of the species identified by the examiner. In the Office Action mailed September 2, 1993, the examiner pointed out why he disagreed with the assertion that claims 1-11, 15, 16, 18-21 and 23 read on the elected invention. In the amendment filed on January 5, 1994, the applicant presented further discussion concerning the examiner's decision not to consider claims 1-11, 15, 16 and 18, and again requested consideration of those claims. In the final Office Action, dated March 18, 1994, the examiner made the restriction requirement final.

In making the restriction requirement final, the examiner disagreed with the applicant's assertion on page 2 of the amendment dated January 5, 1994. That assertion is that claims which use the term "substantially equal" with respect to diameters encompass the species in which the diameters are "equal". The Examiner's position is that claims which use the term "substantially equal" do not encompass species in which the diameters are equal. It is

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not encompass species in which the diameters are equal. It is submitted that the examiner's position would mean that a claim calling for diameters to be "substantially equal" would not be infringed by a structure in which the diameters are equal. Necessarily then, claims calling for diameters to be "substantially equal" would be infringed by structures in which the diameters are not equal. Furthermore, a claim which called for diameters to be "substantially equal" would not be anticipated under 35 USC 102 by a reference showing diameters which are equal.

In contrast to the finding of the examiner, the applicant submits that it is commonly accepted in U.S. patent practice that "substantially equal" does encompass structures in which things are equal. More generally, a claim which calls for something to substantially have a characteristic covers an apparatus or method which has exactly that characteristic, as well as something which has some deviation from the exact characteristic. In J.R. Clark Co. v. Jeuder, Paeschke & Frey Co., 119 USPQ 161 (CA 7, 1958), the court held that there is more flexibility in "substantially coincident" than in "coincident" alone. In Rehrig Controls Co. v. Maxitrol Co., 149 USPQ 19 (DC EMich, 1966) the court held that the operative portions of a valve and seat lying on the surface of a cone are at least substantially conical. In Ex parte Wheeler, 163 USPQ 569 (1969), the Board of Appeals held that a surface which is "substantially parallel" to a fixed direction is to all intents and purposes disposed as closely parallel to such direction as is humanly possible. In In re Faunce, 24 USPQ 251 (CCPA, 1935), the court held that "substantially equal proportions" means that although the proportions may vary slightly, neither will appreciably predominate. In National Research Development Corporation v. Great Lakes Carbon Corporation, et al., 188 USPQ 327, (DC Del, 1975), the court found that the term "substantially" in a particular element of a claim is one commonly used in patents to prevent the avoidance of literal infringement by minor changes which do not themselves cause a loss of the benefit of the invention. The court added that there is authority for the

proposition that the presence of "substantially" should always be implied in every claim, even when not introduced.

The examiner refers to the interpretation that "substantially equal" encompasses the species in which the diameters are "equal" as being inconsistent with the definition and use of the term "substantially equal" in the specification and on page two of the response filed on July 21, 1993. It is submitted that "substantially equal" covers diameters which are precisely equal, as well as some diameters which are not precisely equal. The examiner did not point out how the above interpretation is inconsistent with the definition and use of the term "substantially equal" in the specification and in the response of July 21, 1993.

The applicant submits that there is no inconsistency. As was pointed out in the amendment filed on January 5, 1994, Figs. 2 and 6 show the fitting in an untightened condition, and Figs. 1 and 5 show the fitting in a tightened condition. Figs. 2 and 6 show a gasket having an inner diameter which is initially smaller than the inner diameters of the farthest extending portions of the annular end formations of the tubular elements. However, upon tightening of the fitting, the inner diameter of the gasket is made equal to the inner diameters of the farthest extending portions, as shown in Figs. 1 and 5.

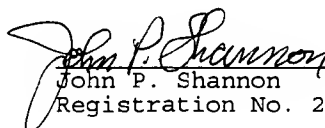
The claims which use the term "substantially equal" rather than "equal" encompass the species of Figs. 1, 2, 5 and 6, as well as other species, since things which are equal are "substantially equal". At the bottom of page 2 of the Election and Amendment filed on July 20, 1993, it was pointed out that at least several, if not most, of the claims of the present application are generic to all of the species identified by the Examiner. Since things which are equal are encompassed by the description "substantially equal", claims which recite "substantially equal" are drawn to the embodiments of Figs. 1, 2, 5 and 6, as well as other embodiments illustrated in the present application.

In view of the foregoing, it is submitted that, in addition to the claims considered by the examiner, at least claims 1-11, 15, 16

and 18 read on the elected species, that is the species of Figs. 1, 2, 5 and 6, and that these claims should be examined in the present application. Accordingly, it is respectfully requested that the Examiner also consider at least claims 1-11, 15, 16 and 18, and that the final Office Action of March 18, 1994 be withdrawn.

Respectfully submitted,

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